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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,722	02/14/2002	Luke David Jagger	NETAP022	1628
28875	7590	01/24/2005	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			BLACKWELL, JAMES H	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,722

Applicant(s)

JAGGER ET AL.

Examiner

James H Blackwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/29/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-19 are directed to non-statutory subject matter. Claim 19 uses the phrase "computer readable medium". However, included among the list of possible "mediums" is a "data signal embodied in a carrier wave" (emphasis added). A carrier wave is not a tangible medium and is therefore not statutory.

Claims 13-17 are also directed to non-statutory subject matter. The claims are in means plus function format and as evidenced by claim 18, one embodiment is software.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Townshend (U.S. Patent No. 6,829,635).

In regard to independent Claim 1 (and similarly independent claims 13, and 18), Townshend teaches identifying bulk email messages. In Fig. 3, step 302 an email message is received by a server (*receiving an electronic mail message*). Townshend

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does not explicitly teach *removing non-static data from the electronic mail message*.

However, Townshend does teach that a signature generator 120 generates one or more signature elements 270 by applying a one-way hash function to a portion of electronic mail message 210 (Col. 6, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time of invention to suggest that these portions consist of a single paragraph, from a single paragraph of a given size, from a set of words in an electronic mail message that are in a dictionary, or from words appearing a given number times, or from all of an electronic mail message but the first and last n lines (Col. 6, lines 59-65).

From this, one would have been motivated to assume that the body of the email message, rather than header and footer information, is preferably used for checksum purposes in effect removing non-static data from the electronic message, as claimed.

Townshend also teaches applying one-way hash functions, which generate numeric values unique to the selected portion of the email message encoded, thus *generating a checksum based on data remaining within the electronic mail message*. Townshend also teaches that a central server 140 receives signatures from a plurality of electronic mail servers, and stores data about the received signatures in received signature store 146 (*a database*). The received signature store is a data structure containing records for signature elements of message signatures received by a central server. The central server uses data in received signature store to determine a count of matching signature elements to return to the electronic mail server (Col. 5, lines 25-32; compare with Claim 1 (and similarly Claims 13, and 18), "... **comparing the generated checksum with a database containing checksums for previously identified unsolicited messages**").

Townshend also teaches that when the central server receives a message signature, the central server generates a count of how many times a matching signature element in the message signature has been previously received. The central server transmits the count of the most frequently matched signature element to the electronic mail server that transmitted the just received message signature. If the count meets a predetermined threshold, the electronic mail server marks the electronic mail message as bulk electronic mail (Col. 3, lines 59-67; compare with Claim 1 (and similarly Claims 13, and 18), “... **identifying the electronic message as an unsolicited message if the generated checksum matches one of the database checksums**”).

In regard to dependent Claim 2 (and similarly dependent Claims 3, 14-15, and 20), Townshend teaches that a signature element may be generated from a single paragraph (*usually lines of data*), from a single paragraph of a given size, from a set of words in an electronic mail message that are in a dictionary, or from words appearing a given number times, or from all of an electronic mail message but the first and last n lines (Col. 6, lines 59-65). Townshend also suggests that multiple elements may be generated and that the signature can be multiple components, or a single number (Col. 7, lines 18-30; compare with Claim 2 (and similarly Claims 3, 14-15, and 20), “... **generating a checksum comprises generating individual checksums for portions of the remaining data**”).

In regard to dependent Claim 4 (and similarly dependent Claim 21), Townshend fails to teach *comparing a checksum comprises comparing checksums starting with one of the portions at the end of the remaining data and working backwards through the*

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data. However, it would have been obvious to one of ordinary skill in the art at the time of invention to assume that since Townshend teaches that multiple signatures (*checksums*) can be created from the body of an email that one way of comparing the signatures for a suspect email would have been to check them by working backwards through the data. The benefit would have been to avoid any schemes that senders of such email might include at the beginning of the body of the email that would prevent the email as being detected as bulk or unsolicited.

In regard to dependent Claims 5-7, Townshend does not explicitly teach *removing non-static material comprises removing forwarding information, headers, and end-of-line characters*. However, Townshend does teach that a signature generator 120 generates one or more signature elements 270 by applying a one-way hash function to a portion of electronic mail message 210 (Col. 6, lines 40-45). It is suggested that these portions consist of a single paragraph, from a single paragraph of a given size, from a set of words in an electronic mail message that are in a dictionary, or from words appearing a given number times, or from all of an electronic mail message but the first and last n lines (Col. 6, lines 58-65). Thus, the body of the email message, rather than header and footer information is preferably used for checksum purposes in effect removing non-static data such as that claimed, from the electronic message.

In regard to dependent Claim 8, Townshend teaches that electronic mail messages that are found to be bulk electronic mail messages may be flagged or deleted

(Col. 3, lines 36-37; compare with Claim 8, “... ***deleting the electronic mail message if the message is identified as an unsolicited message***”).

In regard to dependent Claim 9, Townshend teaches that after the steps are performed, the electronic mail message 210 may be transmitted to one or more other electronic mail servers, or transmitted to one or more electronic mail clients. These recipients of the electronic mail message may then determine whether or not the electronic mail message will be further received or further processed (*at least temporarily storing the electronic message if the message is identified as an unsolicited message*) (Col. 9, lines 1-6).

In regard to dependent Claim 10, Townshend teaches that after the steps are performed, the electronic mail message 210 may be transmitted to one or more other electronic mail servers, or transmitted to one or more electronic mail clients. These recipients of the electronic mail message may then determine whether or not the electronic mail message will be further received or further processed (Col. 9, lines 1-6). From this, one could conclude that if the email is not flagged as being unsolicited (or bulk) it will be sent in the normal fashion to another server or to a client. Compare with Claim 10, “... ***forwarding the electronic message to an intended recipient if the message is not identified as an unsolicited message***”.

In regard to dependent Claims 11-12, and 17, Townshend teaches that at step 376, the received signature store is updated. If a record was found in step 370, the found record is updated with the incremented count. If the age is nonzero, it is set to zero. If a record was not found at step 370, then a new record is created with a count of

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one and an age of zero. Control then flows to step 368 (Col. 8, lines 22-27; compare with Claim 11, “... **updating the database with new checksums**” and Claim 12, “... **the database is updated based on checksums generated from electronic messages received and identified as an unsolicited message**”).

In regard to dependent Claim 19, Townshend teaches that various forms of computer readable media may be involved in carrying one or more sequences of one or more instructions to processor 604 for execution. For example, the instructions may initially be carried on a magnetic disk of a remote computer (Col. 14, lines 3-7; compare with Claim 19, “... **the computer readable medium is selected from the group consisting of CD-ROM, floppy disk, tape, flash memory, system memory, hard drive, and a data signal embodied in a carrier wave**”).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
01/19/05


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER